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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,341	11/28/2000	Wei Min Chin	426882001200	6177

35452 7590 02/12/2004

ACCENTURE C/O MORRISON & FOERSTER  
755 PAGE MILL ROAD  
PALO ALTO, CA 94304

EXAMINER
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NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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Commissioner for Patents

CUONG H. NGUYEN  
Primary Examiner  
Art Unit: 3625

**Office Action Summary**

Application No.

09/722,341

Applicant(s)

CHIN ET AL.

Examiner

CUONG H. NGUYEN

Art Unit

3625

*my*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

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#### DETAILED ACTION

1. This Office Action is the answer to the communication received on 11/07/2002; which paper has been placed of record.
2. Claims 1- 17 are pending in this application.

#### *Drawings*

3. This application has been filed with formal drawings, and they are accepted for examination.

#### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 5A. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### 5B. Practical Application in the Technological Arts:

When an invention is reduced to a practical application in the technological arts, the invention is statutory. Therefore, the claimed invention must produce a "useful, concrete and tangible result" (the pending claims satisfy this requirement); **and** the claimed invention must utilize technology in a non-trivial manner (i.e., the claim **MUST** include a limitation in the technological arts that enables a useful, concrete, and tangible result.

- 5C. The phrase "technological arts" is synonymous with the phrase "useful arts" as it appears in Article I, Section 8 of the Constitution, In re **Waldbaum**, 173 USPQ 430 (CCPA 1972). For a claim to be statutory, it must be in the technological arts. In re

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**Musgrave**, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974).

5D. The technological arts inquiry must focus on whether the claimed subject matter is statutory. In *re Toma*, 197 USPQ 852 (CCPA 1978). In that case, **Toma** held "that the method of enabling a computer to translate natural languages in the technological arts, i.e., claims 1-2 merely providing information".

5E. The invention as recited in those pending claims is merely an abstract idea that is not within the technological arts. Mere ideas that do not positively apply the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. In the body of claims 1-2 must recite technology that positively contributing to each claim's limitation. If the invention in the bodies of these claims are not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), even though **Bowman** is not precedential, *Bowman* is being cited for its analysis of whether the claim is in the technological arts; also note MPEP 2106 IV 2(b).

5F. Merely nominal use of a computer system, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the computer does not affect or effect the underlying process.

### ***Conclusion***

6. The attached prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 703-305-4553. The examiner can normally be reached on 7 am - 330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VINCENT A. MILLIN can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*CHN*  
*Cuong H. Nguyen*

CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3625